

### **REMARKS**

Claims 16-43, 45-47, and 49-56 were pending as of the Final Office Action mailed March 19, 2008. Claims 49-54 are being cancelled. Reconsideration of the action and further examination are respectfully requested in light of the foregoing amendments and the following remarks.

#### **Interview Summary**

Applicants thank Examiner Wassum for the telephonic interview granted on June 12, 2008. During the interview the combination of the references Eldering, Lazarus and Addison were discussed. No agreement was reached.

#### **35 U.S.C. § 101 Rejection**

In the Office Action dated March 19, 2008, the claims 49-54 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Although Applicants do not agree with the rejections, in order to advance prosecution, Applicants have cancelled claims 49-54. Withdrawal of the rejection is respectfully requested.

#### **35 U.S.C. § 103 Rejection of Claims 16-40 and 49-52**

Claims 16-40 and 49-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,134,532 to Lazarus et al. ("Lazarus") in view of European Patent Application EP 0 597 630 to Addison et al. ("Addison") and further in view of U.S. Patent No. 6,298,348 to Eldering.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

### **I. Lazarus Teaches Away From a Combination With Eldering**

In the previous response, Applicants argued that Lazarus teaches away from a combination with Eldering. In the response to arguments in the current Office Action, the Examiner states that

“the Applicants argue that the Eldering references teaches the use of demographic information in selection advertisements, which makes its combination with the Lazarus et al./Addison et al. references improper. In the rejections of record, however, the examiner is not proposing the entire system disclosed by the Eldering reference be bodily incorporated into the system disclosed by the Lazarus et al./Addison et al. references. The Eldering reference is relied upon only for the specific feature that the documents/advertisements are assigned a monetary value according to the correlation between them and the consumer's product preferences, which in this case would correspond to the closeness of the concept of the advertisement to the concept for which the user is searching.” See Office Action, pg. 59.

Applicants respectfully disagree with the Examiner's statements. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The Examiner is merely relying on a portion of Eldering. However, as a whole, Eldering teaches away from a combination with Lazarus. As stated in the previous Office Action, Lazarus describes how the availability of Internet services has allowed consumers to have higher levels of control over information they retrieve, much more control that exists with conventional broadcast models such as radio or television. Lazarus describes that in an Internet services setting, users should similarly have control over the advertisements they see. See Col. 1, ll. 17-24. Eldering teaches targeting advertising based on demographic information. When advertisements are targeted based on a demographic profile, the consumer has no control of the advertisements she sees. See Abstract. A person of ordinary skill in the art interested in designing a system of advertising where the advertisements correspond to received concepts would have **no reason** to borrow from a system that targets advertisements based on a demographic profile. Therefore, in view of the above,

Applicants respectfully submit that claim 16 is allowable over the three-way combination of Lazarus, Addison, and Eldering and respectfully request withdrawal of the rejection of independent claim 16.

## **II. Lazarus and Addison Combination Change the Principle Operation of Each**

The proposed modification to Lazarus and Addison is improper because the combination changes the principle of operation of the combined teachings of Lazarus and Addison. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959); MPEP § 2143.01(IV).

The Examiner proposes a modification that is contrary to the general theme and principle operation of the combination of Lazarus and Addison. Eldering uses pre-gathered demographic information as a way of targeting advertisements. *See* Abstract. This requires that information be known about the consumer before the advertisement can be targeted. If these teachings were to be adopted by the combination of Lazarus and Addison, the combined system would target advertisements based on pre-gathered demographic data **rather** than search terms received by a user. This directly conflicts with the cited combination of Lazarus and Addison. As a result, such a modification is irreconcilable with the manner in which the Lazarus and Addison system would operate. Further, such a modification is irreconcilable with the recited features in the claim. Therefore, in addition to changing the principle of operation of the Lazarus and Addison references, the addition of Eldering results in a three-way combination of teachings that in no way teaches or suggests all of the features of independent claim 16. Therefore, in view of the above, Applicants respectfully submit that claim 16 is allowable over the three-way combination of Lazarus, Addison, and Eldering and respectfully request withdrawal of the rejection of independent claim 16.

## **III. Eldering is not Combinable With Lazarus or Addison**

Eldering does not lend itself to be combined with Lazarus and Addison. Lazarus is directed to a system for delivering targeted entities, such as advertising, coupons, products and

informational content, or users based on their observed behavior. *See* Col. 4, ll. 56-59. Addison is directed to building a concept index from a semantic network of word relationships. *See* pg. 5, ll. 45-49. Eldering is directed to profiling consumers and providing access to the consumer profile in a secure manner. This consumer profile information may then be used to determine the potential applicability of a given advertisement to that consumer. *See* Col. 2, ll. 26-30. Unlike the combined teachings of Lazarus and Addison, Eldering does not use terms entered by a user to provide that user with targeted advertising. Rather, Eldering uses pre-gathered consumer profile information, such as demographic information to target consumers with advertisements. The Eldering teachings are therefore **incompatible** with the combined systems of Lazarus and Addison.

#### **IV. Eldering Does Not Teach “monetary values determined for each of the one or more documents”**

Claim 16 recites “transmitting for display the one or more documents based on an order, the order corresponding to the relationship between monetary values determined for each of the one or more documents identified as related to the received concept or the concepts close in meaning to the received concept.” Claims 23, 29, and 35 recite similar limitations. The Examiner alleges Eldering teaches the above-recited limitations by citing column 3, lines 46-56 of Eldering. Applicants respectfully disagree.

The cited portions of Eldering describe that the system allows for price access to the consumer based on the degree of correlation of an advertisement with the consumer's profile. If an advertisement is found to be very highly correlated with a consumer's demographics and product preferences, a relatively high price can be charged to the advertiser for transmitting the advertisement to the consumer. *See* Col. 3, ll. 46-56. Eldering is therefore merely charging advertisers depending on how related the advertisement is to the consumer's demographics and product preferences. By contrast, the claim requires the monetary values to be **determined for the one or more documents**. Eldering is not associating monetary values for each document, but rather charging based on the correlation of the consumer's profile and the advertisement. Therefore, Eldering does not teach or suggest “transmitting for display the one or more

documents based on an order, the order corresponding to the relationship between monetary values determined for each of the one or more documents identified as related to the received concept or the concepts close in meaning to the received concept,” as recited in claim 16.

For the reasons discussed above, independent claims 16, 23, 29, and 35 are allowable over the three-way combination of Lazarus, Addison, and Eldering and withdrawal of the rejections is respectfully requested. The rejection of cancelled claims 49-52 is moot. Furthermore, since dependent claims 17-22, 24-28, 30-34, and 36-40 depend upon independent claims 16, 23, 29, and 35, respectively, the dependent claims are patentable as least by virtue of their dependency from the independent claims. Therefore, Applicants respectfully request that the rejections of claims 16-40 be withdrawn.

*35 U.S.C. § 103(a) rejection of claims 41-43, 45-47, and 53-56*

Claims 41-43, 45-47, and 53-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Addison in view of Eldering.

**I. Claims 41-43 and 45-47**

Claim 41 recites “identifying one or more documents associated with the one or more concepts close in meaning to the received concept, **wherein the association of documents with concepts is based in part on a monetary value.**” Claim 45 recites similar limitations. The Examiner states that Addison does not explicitly teach a method wherein the association of the documents with the concepts is based in part on a monetary value and relies on Eldering for an alleged teaching. Applicants respectfully disagree.

The cited portions of Eldering that are relied upon for this alleged teaching describes that “content/opportunity provider can charge advertiser 144 for access to consumer 100 during an opportunity. The price charged for access to consumer 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100.” See Col. 6, ll. 37-42. Eldering also discloses that “if an advertisement is found to be very highly correlated with a consumer’s demographics and product preferences, a relatively high price can be charge for transmitting the advertisement to the consumer.” See Col. 3, ll. 48-52.

Neither of these disclosures teach or suggest “wherein the association of documents with the concepts is based in part on a monetary value,” as recited in claim 41. Eldering’s teaching of charging for access to a consumer is not even related to an “association of documents with the concepts is based in part on a monetary value.” Furthermore, charging a high price for transmitting the advertisement to the consumer also has no correlation to “wherein the association of documents with the concepts is based in part on a monetary value.” In fact, any disclosure of “wherein the association of documents with the concepts is based in part on a monetary value,” is completely missing from Eldering. Accordingly, Addison and Eldering do not disclose, teach or even suggest all of the elements and limitations of the independent claims 41 and 45. The Applicants therefore respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of independent claim 41 and 45, as well as all dependent claims 42-43 and 46-47.

## **II. Claims 53-56**

Independent claim 55 recites “assigning a monetary value to the elements in the target data set, and ordering matched target data elements from the target data set in accordance with closeness in meaning between the search request and the larger set of search terms.” As discussed above with regard to claim 16, Eldering does not teach or disclose this claim limitation. In addition, as discussed above with regard to claim 16, Eldering cannot be combined with Addison.

For the reasons discussed above, independent claim 55 is allowable over Addison, and Eldering and withdrawal of the rejections is respectfully requested. Furthermore, since dependent claim 56 depends upon independent claims 55, claim 56 is patentable at least by virtue of its dependency from the independent claim 55. The rejection of cancelled claims 53-54 is moot. Therefore, Applicants respectfully request that the rejections of claims 55-56 be withdrawn.

## **Conclusion**

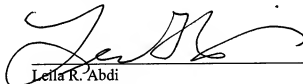
For the foregoing reasons, the Applicants submit that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the Applicants do not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicants' selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicants' decision to amend or cancel any claim should not be understood as implying that the Applicants agree with any positions taken by the examiner with respect to that claim or other claims.

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Respectfully submitted,

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Lella R. Abdi  
Reg. No. 52,399

Customer No. 26192  
Fish & Richardson P.C.  
Atlanta, GA 30309  
Telephone: (404) 892-5005  
Facsimile: (877) 769-7945